

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed April 19, 2006.

As an initial matter, Applicants gratefully acknowledge the Examiner's indication of the allowability of the subject matter of claim 97. Accordingly, Applicants have rewritten claim 97 into independent form at this time to include the subject matter of base claim 80 and intervening claim 96. Accordingly, claim 97 is now in *prima facie* condition for allowance.

By this Amendment, Applicants cancel claims 1-79 and 81, without prejudice or disclaimer, amend the specification, additionally amend claims 80, 82, 83, and 93, and add new claims 105-115. The originally-filed specification, drawings, and claims fully support the subject matter of amended claims 80, 82, 83, and 93, and new claims 105-115. No new matter has been introduced.

On pages 2-3 of the Office Action, the specification was objected to. Applicants have amended the specification as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

On page 3 of the Office Action, claims 81-83 were objected to. Applicants have cancelled claim 81, without prejudice or disclaimer, rendering that rejection moot. Applicants have also amended claims 82 and 83 to clarify that the first and second configurations are of the rail relative to the post. Accordingly, Applicants respectfully request withdrawal of the claims objections.

On pages 3-4 of the Office Action, claims 83 and 95 were rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Applicants respectfully traverse these rejections.

Claim 83 was rejected because the phrase “the rail is not in the substantially horizontal orientation” is allegedly indefinite. However, Figs. 7 and 8 disclose exemplary configurations where “the rail is not in the substantially horizontal orientation.” For example, Fig. 8 illustrates a rail (30) forming an obtuse inner angle with a vertical post (21).

Claim 95 was rejected because the phrase “another rail cannot be mounted to the post via the bracket in the second configuration” is allegedly indefinite. However, Applicants respectfully submit that this is not indefinite, as “when the rail is mounted to the post via the bracket in the first configuration,” for example, as shown on the right side of Fig. 9, “another rail cannot be mounted to the post via the bracket in the second configuration,” for example, as shown on the left side of Fig. 9. Indeed, the Office Action acknowledges this by reciting that “the bracket is capable of supporting one end of the rail at one time,” showing that the subject matter of claim 95 is indeed definite.

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of the Section 112, second paragraph, rejections.

On pages 4-5 of the Office Action, claims 80-96, 99, and 104 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,788,223 to Platt (“Platt”). Applicants respectfully traverse this rejection.

Platt does not disclose or suggest the claimed invention. For example, independent claim 80 recites a rail assembly including, among other aspects, “wherein

in the first configuration of the rail relative to the post, a longitudinal axis of the rail is at a first angle relative to the mounting surface of the post, and in the second configuration of the rail relative to the post, the longitudinal axis of the rail is at a second angle relative to the mounting surface of the post different from the first angle." Platt does not disclose at least this aspect of the invention either alone or in combination with the other aspects of the invention.

Specifically, even assuming *arguendo* that Platt discloses a first configuration, in Figs. 1, 2, 9, and 15, where a longitudinal axis of fence rail 2 is at a first angle relative to a mounting surface of fence post 3, Platt does not disclose a second configuration where the longitudinal axis of fence rail 2 is at second angle different from the first angle relative to the mounting surface of fence post 3. Indeed, Platt discloses only one configuration where fence rail 2 appears to be at a 90 degree angle relative to fence post 3. By contrast, Fig. 9 of the present application discloses examples of the first and second configurations (e.g., the configurations of rail 30 on the left and right sides of post 21) that meet the aforementioned aspects of claim 80. Accordingly, Platt does not disclose the subject matter of independent claim 80.

Moreover, claim 83 recites "wherein... the rail is configured to be mounted to the post at an angle relative to a longitudinal axis of the post such that the rail is not in the substantially horizontal orientation." Platt does not disclose that fence rail 2 is not in a substantially horizontal orientation relative to fence post 3, for example, as shown in Figs. 7 and 8 of the specification.

Additionally, claim 89 recites "wherein each of the at least two first surface are parallel to each other." Page 5 of the Office Action asserts that the "two surfaces [that]

are inclined from top of element 32" in Platt correspond to the at least two first surfaces. Even assuming *arguendo* that this is correct, these alleged "at least two surfaces" of Platt are not parallel to each other as set forth in claim 89. A similar argument may be applied to claim 92.

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of the Section 102(b) rejection based on Platt.

On pages 5-6 of the Office Action, claims 98 and 100-103 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Platt. Applicants respectfully traverse this rejection.

Initially, Applicants respectfully traverse the obviousness rejection at least because the Office Action does not set forth how the aforementioned deficiencies of Platt set forth in the Section 102(b) rejection are obvious in view of Platt.

Moreover, Applicants respectfully disagree with the statement that "[i]t would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the angle of first surface, second surface and third surface to 45 degree to provide designer's preference for improving of the railing assembly." To the contrary, Applicants assert that to modify any of the alleged surfaces set forth in the drawing on page 5 of the Office Action would have made it more difficult for fence rail clip 1 to retain fence rail 2, which may impermissibly destroy the purpose of the invention and render it unsatisfactory for its intended purpose. See In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For example, if the alleged surfaces of Platt were pointed "inward" to form a 45 degree angle, fence rail 2 would only rest along an interior edge of the alleged surfaces,

creating instability along that interior edge, and if the alleged surfaces were pointed "outward" to form a 45 degree angle, no part of the alleged surfaces would be able to retain any portion of fence rail 2.

Furthermore, the above-stated motivation is an impermissible conclusory statement that is neither "clear and particular," as required by In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999), nor found in the prior art, as required by In re Vaeck, 947 F.2d 488, (Fed. Cir. 1991). Indeed, it appears the Office Action has impermissibly taken Platt in view of Applicants' disclosure, with a good bit of hindsight, to arrive at the claimed invention. Such a path of arriving at the claimed invention is not sufficient to justify a motivation under Section 103(a).

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of the Section 103(a) rejection based on Platt.

Applicants further submit that each of claims 82-96 and 98-115 depends directly or indirectly from one of independent claims 80 and 97, and each is therefore allowable for at least the same reasons that respective independent claims 80 and 97 is allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the references and therefore each is also separately patentable.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

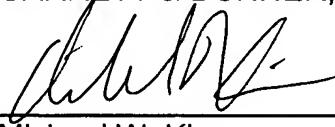
In discussing the claims in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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